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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/498,515

02/04/2000

Howard G. Page

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05/27/2005

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EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/498,515

Applicant(s)

PAGE ET AL.

Examiner

Yehdega Retta

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18, 20-23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-18, 20-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

This office action is in response to amendment filed March 9, 2004. Claims 1-8, 10-18, 20-23, 25-27 are currently pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-18, 20-23, 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swix et al. U.S. Patent No. 6,718,551 further in view of "NDS: NDS' XTV(TM) time shifting technology empowers the viewer and the broadcaster", M2 Presswire, Sep 10, 1999, (hereinafter XTV(TM)).

Regarding claims 1 6-8, 11, 12, 16-18, 21, 22 and 26, Swix teaches selecting video advertising that has a subject matter relation to the selected video content requested by the target viewer; inserting the selected video advertising, into the video stream that transfers the selected video content to the target viewer; caching the video advertising using user device, displaying the video advertising and the selected video content to the viewer; interface (see fig. 1&2, col. 6 line 26 to col. 7 line 51, col. 8 line 66 to col. 9 line 44, col. 11 line 23 to col. 12 line 20, col. 13 lines 9-54). Swix does not teach disabling fast-forward capability when the selected video advertising is displayed. XTV(TM) teaches a set-top-box which provides advertisers with the ability to totally prevent views from skipping ads. It would have been obvious to one of ordinary

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skill in the art at the time of the invention to disable the ability of fast-forward or skip forward in order to force the subscriber to view the commercials (see page 1).

Regarding claims 2, 13 and 23 Swix teaches inserting points in the selected video content for the selected advertisement and inserting the selected advertisement at the insertion point (see fig. 5 and col. 12 line 61 to col. 13 line 9).

Regarding claims 3, 4, 14 and 15, Swix teaches transferring the video content over first transport system and the advertising over a second transport system (see col. 13 lines 9-3).

Regarding claims 5 and 27. Swix teaches selecting the video ad based on a viewer profile for the target viewer (see col. 7 line 31 to col. 8 line 2, col. 8 line 66 to col. 9 line 44)

Regarding claims 10, 20 and 25, Swix does not explicitly teach re-displaying the selected video advertisements after rewinding the video content. It would have been obvious for Swix to re-display the same advertising since the advertisement selected is cached at the client set-top box and is inserted into the video stream, locally at a client side, and presented to the viewer.

### ***Response to Arguments***

Applicant's arguments, filed March 9, 2004 with respect to the rejection(s) of claim(s) 1-8, 10-18, 20-23 and 25-27, under 35 USC § 103, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of "NDS' XTV (TM) time shifting technology empowers the viewer and the broadcaster".

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Eldering (US 6,615,039 B1) teaches inserting advertisement into streaming media, based on viewer profile.

Suzuki (US 6,493,763 B1) teaches inserting commercial advertisement into video-on-demand at a proper timing.


Bhagavath et al. (US 6,505,169 B1) teaches inserting streaming content based on conditions pre-selected by the source of the advertising.

Eyer et al. (US 6,588,015) teaches disabling fast-forward of advertisement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yehdega Retta  
Primary Examiner  
Art Unit 3622

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